

REMARKS

The Office Action dated April 24, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1, 11-17, 21-25, and 27-65 are currently pending in the application, of which claims 1, 21, 23-24, 27-28, and 50-52 are independent claims. Claims 1, 11-17, 19, and 24 have been amended, and claims 53-65 have been added, to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 3-10, 18, 20, and 26 have been canceled without prejudice or disclaimer. Claims 1, 11-17, 21-25, and 27-65 are respectfully submitted for consideration.

Claims 1 and 3-52 were rejected under 35 U.S.C. 101, as allegedly being directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

The rejection is not a *prima facie* rejection for lack of statutory subject matter. For example, according to the Office Action, "Claims 1 recite 'a system of presence information and an entity, which is just software, per se.'" (all errors in Office Action) In fact, of course, while claim 1 does recite a system, and does recite presence information and an entity as features of that system, claim 1 does not recite "just software." For example, one of ordinary skill in the art would appreciate that an entity is not "just software," as can be seen from dependent claim 5, which provides one example, in which the entity is a user equipment.

The Office Action asserted that a “computer program is non-statutory because it is not considered a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” This assertion, however, is not supported by law. For example, *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) held a computer program to be statutory. Thus, it is not the case that because something is directed to a computer program. Indeed, Supreme Court precedent has indicated that “anything under the sun made by man” (*Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, (1980)) is patentable subject matter. There can be no reasonable doubt that computer programs are made by man. Thus, it follows that *prima facie* the claims (including claim 1) are directed to statutory subject matter, even if they are directed to a computer program (not admitted).

Finally, the Office Action asserted that “Because the claim may be directed toward a program the claim as a whole is considered non-statutory.” The Office Action provided no basis for this assertion except the already-refuted explanation discussed above. Furthermore, since the burden of establishing unpatentability is on the USPTO, an assertion that the claim “may be directed toward” something that is alleged to be non-statutory subject matter would not suffice to provide a *prima facie* rejection.

Furthermore, the rationale for the rejection is inapplicable to claims 21 and following, none of which are directed toward a system, as recited in claim 1. For example, claim 21 recites a method, which clearly falls within the statutorily protected category of “process.” Likewise, claims 51-52 recites computer-readable media, which

clearly fall within the statutorily protected category of “manufacture.” Thus, it is respectfully requested that the rejection be withdrawn as clearly improper.

Claims 1 and 3-52 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,993,327 of Mathis (“Mathis”) in view of U.S. Patent Application No. 2004/0062383 of Sylvain (“Sylvain”) and further in view of U.S. Patent Application Publication No. 2003/0009530 of Philonenko (“Philonenko”). The Office Action acknowledged that Mathis fails to disclose or suggest all of the features of any of the claims, and cited Sylvain to remedy certain of those deficiencies. Nevertheless, the Office Action further recognized that the combination of Mathis and Sylvain was still unable to disclose or suggest all of the elements of the claims. Accordingly, the Office Action further cited Philonenko to remedy the deficiencies of the combination of Mathis and Sylvain. It is respectfully submitted that the combination of Mathis, Sylvain, and Philonenko

Claim 1, upon which claims 12-19 depend, is directed to a server including a memory configured to store presence information associated with at least one user, the presence information including a plurality of parts, at least one of the parts including information identifying an application for which the at least one part is intended. The server also includes a processor configured to provide to at least one entity presence information associated with the at least one user, the at least one entity including at least one application, the at least one entity being configured to use the information identifying the application to obtain the at least one part of the presence information for the at least one application.

Claim 21, upon which claims 22 and 53-57 depend, is directed to a method including receiving at least a portion of presence information associated with a user, the presence information including a plurality of parts, at least one of the parts including information identifying an application for which the at least one part is intended. The method also includes obtaining in at least one entity at least one of the parts, the at least one entity including at least one entity application, the at least one entity obtaining the parts including information identifying the at least one entity application for the at least one application.

Claim 24, upon which claims 25 and 37-49 depend, is directed to an apparatus including at least one application. The application also includes at least one processor configured to obtain at least one part of presence information associated with an user, the at least one part including information identifying at least one of the at least one applications. The processor is configured to obtain the at least one part including information identifying the at least one application for the at least one application.

Claim 27 is directed to an apparatus including associated presence information, wherein the presence information includes a plurality of parts. The apparatus also includes provision means for providing at least one of the parts with information identifying an application for which the at least one part is intended.

Claim 28 is directed to an apparatus including at least one application. The apparatus also includes at least one application obtaining means for obtaining at least one part of presence information associated with an user, the at least one part including information identifying at least one of the at least one a application. The obtaining means

is configured to obtain the at least one part including information identifying the at least one application.

Claim 50, upon which claims 58-65 depend, is directed to a method including providing presence information, wherein the presence information includes a plurality of parts, wherein at least one of the parts is provided with information identifying an application for which the at least one part is intended.

Claim 51 is directed to a computer readable medium including a first computer executable component configured to provide presence information, wherein the presence information includes a plurality of parts, wherein at least one of the parts is provided with information identifying an application for which the at least one part is intended.

Claim 52 is directed to a computer readable medium including a first computer executable component configured to use presence information associated with at least one user, wherein the presence information includes a plurality of parts, at least one of the parts including information identifying an application for which the at least one part is intended, the first computer executable component configured to use the information identifying the application to obtain the at least one part of the presence information intended for the at least one application.

Applicants respectfully submit that the combination of Mathis, Sylvain, and Philonenko fails to disclose or suggest all of the elements of any of the presently pending claims.

Mathis generally relates to multicast distribution of presence information for an instant messaging system. The contact list in Mathis, however, is not “presence

information.” Mathis does describe presence information in column 2, lines 25 to 33. Column 4, lines 49 to 55, of Mathis likewise give some examples of that presence information. The presence information is indicated as being online status, offline status, location attribute and capabilities, device attributes and capabilities, communication network attributes and capabilities. However, there is no suggestion or disclosure that this presence information includes information identifying an application for which presence information is intended.

Thus, Mathis fails to disclose or suggest, “said at least one entity being configured to use said information identifying the application to obtain the at least one part of said presence information for said at least one application,” as recited (for example) in claim 1.

The previous Office Action had acknowledged that Mathis does not disclose such a feature and had cited Philonenko. The present Office Action acknowledged that Mathis does not disclose such a feature, implicitly acknowledged that Philonenko likewise does not disclose such a feature, and cited Sylvain as allegedly disclosing such a feature.

Sylvain generally relates to presence information for telephony users. Reference is made in Sylvain to presence applications subscribing to the presence server. Based on the subscription, the presence server delivers presence information to the subscribing presence application. Reference is made to a profile which typically identifies devices and their respective states to monitor, provide rules for evaluating the state information to generate the presence information and identify individuals, systems or applications

authorized to receive the information. Such information can be gleaned from paragraph [0035] of Sylvain.

Although paragraph [0035] of Sylvain mentions applications, such mention is not in the same context as in the present application. That is, there is no disclosure that the presence information includes information which identifies an application for which it is intended. Thus, when a user terminal, for example, receives presence information, the information identifying the application can be used to direct the presence information received to the particular application on the user terminal for which the presence information is intended. This is not disclosed or suggested by Sylvain.

Accordingly, it can be seen that Sylvain does not remedy the admitted deficiencies of the combination of Mathis and Philonenko with respect to “said at least one entity being configured to use said information identifying the application to obtain the at least one part of said presence information for said at least one application,” as recited (for example) in claim 1. Thus, the combination of Mathis, Sylvain, and Philonenko fails to disclose this feature, and it is respectfully requested that the rejection of claim 1 be withdrawn.

For completeness, Philonenko is also discussed. As noted above, the Office Action also cited Philonenko. Philonenko generally relates to an instant message presence protocol for facilitating communication center activity. Philonenko also fails to disclose that the presence information additionally includes information identifying the application for which the presence information is intended.

Philonenko discusses in paragraph [0146] using a parameter identifying the client. It is clear from the context that the client being discussed is a person, see for example paragraph [0003], [0012], and [0016]. In paragraph [0059], (to provide another example) software needs to be sent to a client on a CD.

Again, there is no suggestion or disclosure that presence information be provided additionally with information identifying an application on an entity for which said at least one part of said presence information is required.

In short, there is no suggestion or disclosure that the presence information of Philonenko is other than the standard presence information. The abstract of Philonenko summarizes the disclosure of Philonenko as a software monitoring and reporting application provided for reporting presence information of network entities in real time. The application, according to the abstract, includes a software agent for generating a presence information model; a data store for detecting presence information tuples; and a monitor for detecting presence information updates and for synchronizing the updated information in the data store.

Thus, such disclosure cannot reasonably be regarded as a disclosure of a situation in which the presence information itself includes information identifying an application for which the presence information is intended.

Each of the other independent claims (each of which has its own scope) recites at least some similar features to those discussed above with respect to claim 1. For example, claim 21 recites, in part, “receiving at least a portion of presence information associated with a user, said presence information comprising a plurality of parts, at least

one of said parts comprising information identifying an application for which said at least one part is intended.” It is respectfully submitted that the combination of Mathis, Sylvain, and Philonenko fails to disclose or suggest this feature of claim 21 or the other similar or related features of the other independent claims (which each have their own scope). It should be noted that the independent claims were not separately rejected, and consequently the same explanation above should properly establish the patentability of each of the independent claims. Thus, it is respectfully requested that the rejection of each of claims 1, 21, 23-24, 27-28, and 50-52 be withdrawn.

Claims 11-17, 22, 25, 29-49, and 53-65 depend respectively from, and further limit, claims 1, 21, 23-24, and 50. Thus, each of claims 11-17, 22, 25, 29-49, and 53-65 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that the rejection of all of claims 11-17, 22, 25, 29-49, and 53-65 be withdrawn.

Claims 3-10, 18, 20, and 26 have been canceled without prejudice or disclaimer, and consequently the rejection of claims 3-10, 18, 20, and 26 is moot and should be withdrawn.

Additionally, it is respectfully submitted that the proposed combination of Mathis, Sylvain, and Philonenko would not have been obvious to one of ordinary skill in the art. None of the cited references, as demonstrated above, discloses the concept of “presence information comprising a plurality of parts, at least one of said parts comprising information identifying an application for which said at least one part is intended.”

Furthermore, there is no motivation, teaching, or suggestion in the art pointing to the provision of such presence information as particularly recited.

The Office Action's discussion of motivation to combine at pages 4-6 of the Office Action does not address this issue. In other words, the Office Action's discussion does not provide some alleged teaching, suggestion, motivation, or other reason one of ordinary skill in the art would begin from the combined teachings of Mathis, Sylvain, and Philnenko and arrive at the claimed invention, in particular at least at the feature "presence information comprising a plurality of parts, at least one of said parts comprising information identifying an application for which said at least one part is intended," as recited in (for example) claim 21.

Furthermore, the Office Action's proposed motivation to combine (as best understood), relies on the inventors' own alleged activity (see last line of page 5 of the Office Action), which is clearly improper. As set forth in 35 U.S.C. 103(a), "Patentability shall not be negated by the manner in which the invention was made." Likewise, the inventors' own activity (whether or not the Office Action has properly characterized it) must be excluded from consideration as explained in MPEP 2142 ("Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'difference'"). Accordingly, it is respectfully submitted that for this additional reason, the rejection of the claims is improper and must be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 1, 11-17, 21-25, and 27-65 recite subject matter that is neither disclosed nor suggested in the

cited art. It is, therefore, respectfully requested that all of claims 1, 11-17, 21-25, and 27-65 be allowed and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Additional Claims Transmittal
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